Supreme Court, U.S.
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No. 01-0035

In The

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Did the Federal Circuit correctly interpret the claim element "module" to be a "housing," using the language in Claim 1 and the specification and drawings?

2. Under this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Co.*, 520 U.S. 17 (1997), does file wrapper estoppel arise when the patentee offers the Federal Circuit no explanation for a claim amendment?

3. Under the doctrine of claim differentiation, did the Federal Circuit properly construe an independent claim to not include an element contained in a dependent claim?

4. Under the doctrine of equivalent's corollary to the "all limitations" rule, did the Federal Circuit correctly conclude that Claim 1 does not embrace a "sensing means" outside of the housing or module in which the receiving circuit is located?

CORPORATE DISCLOSURE STATEMENT

R.F. Technologies, Inc. has no parent corporation and has issued no shares to the public.

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STATEMENT OF THE CASE

This case involves the construction of Claim 1 of U.S. Patent No. 4,682,155 (the " '155 Patent") owned by Petitioner, Senior Technologies, Inc. The '155 Patent covers a wanderer monitoring system that has a transmitter affixed to the limb of the monitored individual, a sensing module mounted adjacent to a monitored door, a door switch mounted on a monitored door, and an alarm. (Joint Appendix before the Federal Circuit, A000084, Col. 8:57-68.)

Claim 1 recites the components of the security sensing system to include "a sensing module for installing adjacent" to a monitored door. (Joint Appendix before the Federal Circuit, A000084, Col. 8:61-62.) The sensing module responds to the signals from the transmitter and produces an output response which in turn energizes an alarm, when the monitored door is open. (Joint Appendix before the Federal Circuit, A000084, Col. 8:63-68.) The sensing module is defined as "including a receiving circuit and associated sensing means," all of which are adjacent to the monitored door. (Joint Appendix before the Federal Circuit, A000085, Col. 9:5-7). Claim 1 specifies that the receiving circuit is inside the sensing module. (Joint Appendix before the Federal Circuit, A000085, Col. 9:9-10.)

Petitioner originally accused eighteen (18) systems of infringing all 18 claims of the '155 Patent, as well as claims in another patent owned by Petitioner which was not the subject of the appeal to the Federal Circuit, and is not the subject of the Petition for Certiorari. (Appendix C, p. 30, footnote 3.) At the close of Plaintiff's case, the

district court dismissed the infringement claims against fourteen of the eighteen accused systems due to Petitioner's failure to offer sufficient evidence concerning the operation of these accused devices and how these devices allegedly infringed the patents at issue. (Appendix C, p. 30, footnote 3.) At the conclusion of the trial, the court found the four remaining accused devices did not infringe any of the claims of the '155 Patent or the other patent owned by Petitioner. (Appendix C, pp. 30, 52, ¶ 18; pp. 56-57, ¶ 28.)

The district court found that Claim 1 disclosed a "sensing module" with a receiving circuit inside that responded to the signals from the transmitter and produced a response. (Appendix C, pp. 31-32, ¶ 6.) Claim 1 required the sensing module to be mounted adjacent to the monitored door. *Id.* The district court also found that the sensing module mounted adjacent to the door included the "sensing means" or antenna. (Appendix C, pp. 48-49, ¶¶ 11-12.) The district court found that the accused products did not have **both** the claimed receiving circuit and associated sensing means in the sensing module located adjacent to the door and therefore they did not infringe Claim 1. (Appendix C, p. 52, ¶ 18.) This difference was one of three bases on which the district court found the four accused devices did not infringe Claim 1. (Appendix C, p. 52, ¶ 18.) The district court also concluded that the accused devices did not have the "receiving circuit" disclosed in Claim 1 and the accused devices were always enabled, whereas the receiving circuit in the '155 Patent was disabled until the door switch ("means to enable") enabled the receiving circuit. (Appendix C, p. 52, ¶¶ 18, 20; pp. 56-57, ¶ 28.)

Petitioner appealed some but not all issues relating to four claims (1, 2, 6 and 8) of the '155 Patent. Petitioner **did not** appeal the district court's construction of the "sensing module" in Claim 1 and specifically did not appeal the district court's conclusion that the receiving circuit **and** "sensing means" or antenna are in a single sensing module, which must be located adjacent to the monitored door. Instead, Petitioner appealed the construction of Claim 6 which was not the subject of Petitioner's subsequent Petition for Rehearing to the Federal Circuit and is not the subject of the Petition for Certiorari. (Appellants Brief before the Federal Circuit, pp. 50-52.)

Petitioner's only argument on appeal to the Federal Circuit relating to the sensing module in Claim 1 was challenging the district court's *factual conclusion* that the receiving circuit and sensing module *in the accused devices* are not all located adjacent to the monitored door. Petitioner argued they **could** be located adjacent to the door and it was error for the district court to find to the contrary. (Appellant's Brief before the Federal Circuit, pp. 51-52.)

Petitioner's principal focus on appeal was the district court's conclusion that the accused products did not have the disclosed receiving circuit and that the disclosed receiving circuit was disabled until the door switch ("means to enable") enabled the receiving circuit, unlike the accused devices, which were always enabled. (Appellant's Brief before the Federal Circuit, pp. 22-50, 53-59.)

The Federal Circuit agreed the receiving circuit in Claim 6 was disabled until enabled, disagreed that the receiving circuit in Claim 1 was disabled until enabled

and concluded the district court erred in its comparison of the accused products' receiving circuit to the disclosed receiving circuit. (Appendix A, pp. 7-8, 9-10, 19.) Petitioner incorrectly states that the Federal Circuit found the district court's finding of non-infringement was clear error. The Federal Circuit held the district court's conclusions that the accused products did not have the disclosed receiving circuit was clear error. (Appendix A, p. 9.) The Federal Circuit **affirmed** the district court's finding of non-infringement based on its construction of the sensing module, which was consistent with the district court's construction. (Appendix A, pp. 12-13, 14, 16.) While Petitioner sought rehearing on the Federal Circuit's construction of the "sensing module" in Claim 1, Petitioner **never** challenged the district court's construction of the "sensing module" in its original appeal to the Federal Circuit. (Appellant's Brief before the Federal Circuit, pp. 50-52.)

Key to the Federal Circuit's infringement analysis was the composition and location of the "sensing module," the device that receives signals from a transmitter, and produces an output response to energize an alarm. The Federal Circuit concluded that the patent required the "sensing means" or antenna (the device that receives the signal from the transmitter) and the receiving circuit (the device that produces an output response to energize an alarm) be part of the sensing module, which must be located adjacent to a monitored door. (Appendix A, pp. 10-11, 13, 14.)

Four accused devices are the subject of the Petition for Certiorari. (Appendix A, p. 5.) Three devices (the CA 9100, 9120 and 600) do not have the receiving circuit (as

construed by the Federal Circuit) in a single sensing module located adjacent to the door. (Appendix A, p. 13.) Rather, only part of the receiving circuit is included in a module located adjacent to the door. (Appendix A, p. 13.) The other part is in another unit, a control unit, mounted at a different and arbitrary location. (Appendix A, p. 13.) The fourth device (the CA 9000) does not have a "sensing means" or antenna and receiving circuit in a single unit mounted adjacent to the monitored door. (Appendix A, p. 16.) Only the antenna is mounted near the door. The entire receiving circuit is in a different unit at another location. (Appendix A, p. 16.)

Contrary to Petitioner's assertion, the Federal Circuit did not rely on Claim 6 to construe the "sensing module" to be a "housing." Rather, based on the language in Claim 1, as reinforced by the specification, the Federal Circuit concluded the "sensing module" was a single unit in which the receiving circuit and "sensing means" or antenna were located, and the single unit was mounted adjacent to the door. (Appendix A, p. 15.) The Federal Circuit used the term "housing" to describe the module. The Federal Circuit concluded that the accused devices do not have a single unit mounted adjacent to the door which include both the receiving circuit and sensing means and, therefore, they do not infringe Claim 1. (Appendix A, pp. 10-11.)

Specifically, the Federal Circuit concluded that three devices (the CA 9100, 9120 and 600) do not have the entire receiving circuit in the sensing module located adjacent to the door. (Appendix A, p. 13.) Therefore, they do not literally infringe.

Likewise, the CA 9000 only has a "sensing means" or antenna adjacent to the door. *Id.* The receiving circuit is located at another arbitrary location. Applying the doctrine of claim differentiation, the Federal Circuit concluded that the "sensing module" in Claim 1 could not be expanded to include a device that had one unit containing the receiving circuit and another unit containing the "sensing means." (Appendix A, p. 15.) The court reached this conclusion by comparing Claim 1 to Claim 4, a dependent claim to Claim 1, and finding that Claim 4 defines the invention as having a sensing module adjacent to the door, but only including the receiving circuit. (Appendix A, pp. 14-15.) The "sensing means," or antenna, is in another unit mounted over double doors. (Appendix A, p. 15.) Applying the doctrine of claim differentiation, the Federal Circuit concluded to construe Claim 1 to allow the sensing means to be located in a unit other than in the sensing module would render Claim 4 superfluous. (Appendix A, p. 15.) Therefore, the Federal Circuit concluded the CA 9000 did not literally infringe Claim 1. (Appendix A, p. 16.)

The Federal Circuit also analyzed all four units under the doctrine of equivalents. As to three devices (the CA 9100, 9120, and 600), the Federal Circuit concluded there was no infringement under the doctrine of equivalents because the definition of "sensing module" in Claim 1 was amended to overcome a rejection based on indefiniteness and the amendment specifically recited that the receiving circuit was in the sensing module. (Appendix A, pp. 13-14.) Petitioner never offered any alternative explanation for this amendment and the Federal Circuit

concluded prosecution history estoppel applied. (Appendix A, p. 14.) Therefore, the devices (the CA 9100, 9120 and 600) in which only part of the receiving circuit (as defined by the Federal Circuit) was in the sensing module adjacent to the door did not have an element equivalent to the claimed sensing module. *Id.*

Relying on the doctrine of equivalent's corollary to the "all limitations" rule, the Federal Circuit concluded Claim 1 did not disclose a device with an antenna located in a separate unit. Since the concept of equivalency did not embrace this structure, but rather it was specifically excluded from the scope of the claim, the claim could not be expanded under the doctrine of equivalents. (Appendix A, pp. 16-17.) Therefore, the CA 9000, which has an antenna in one unit and a receiving circuit in another unit did not infringe Claim 1 under the doctrine of equivalents. (Appendix A, pp. 16-17.) The Federal Circuit relied on its decision in *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996) to reach this conclusion.

SUMMARY OF ARGUMENT

This case does not warrant review. Petitioner argues the decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381 (Fed. Cir. 1999) was improperly applied and that the Federal Circuit improperly imported a claim limitation into Claim 1, thereby creating confusion among patentees and the public concerning the construction of claims and the effect claim amendments have on the breadth of a claim. Petitioner raises these

issues with the hopes of "tagging along" on this Court's recent grant of certiorari in *Festo*.

However, as will be demonstrated below, whatever this Court decides in *Festo* will have no impact on the Federal Circuit's decision in this case. Further, the Federal Circuit's decision does not conflict with the law of any case decided by this Court or the Federal Circuit regarding claim construction. Rather, Petitioner's complaint essentially boils down to alleged errors in the construction of the "sensing module" and "sensing means" in Claim 1 of the '155 Patent and alleged factual errors concerning the reason for the amendment to the meaning of "sensing module." Yet, Petitioner never argued in its appeal to the Federal Circuit that the district court's construction of these elements was erroneous. Further, the Petitioner never offered to the Federal Circuit any explanation for the amendment. Therefore, Petitioner waived any rights to challenge that construction and the Federal Circuit's affirmance of that construction. Petitioner also waived any right to challenge the Federal Circuit's conclusion that the amendment related to patentability.

The construction of "sensing module" as being a compact unit that includes both the receiving circuit and "sensing means" or antenna is consistent with the claim language and the specification. Use of the word "housing" to describe the module is consistent with the specification and imports no limitation not already in the claim. Likewise, the Federal Circuit's findings concerning the "sensing means" do not conflict with any decision of this Court or the Federal Circuit. Based on the doctrine of claim differentiation, the Federal Circuit concluded the

Claim 1 "sensing means" did not encompass a sensing means outside of the unit with the receiving circuit. Therefore, the CA 9000 did not literally infringe Claim 1. Based on the doctrine of equivalents' corollary to the "all limitations" rule, the Federal Circuit further concluded that the language in Claim 1 describing the "sensing means" as being included in the sensing module with the receiving circuit, precluded an expansion of that element to cover a sensing means outside of that unit. Therefore, the CA 9000 did not infringe under the doctrine of equivalents.

Further, the amendment directly affected the meaning of the element "sensing module." Since Petitioner never offered to the Federal Circuit any explanation for the amendment made to this element, under this Court's decision in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 137 L.Ed.2d 146, 117 S.Ct. 1040 (1997), the Federal Circuit's application of prosecution history estoppel was appropriate. The fact the Federal Circuit cited to *Festo* as support for this conclusion does not give rise to grounds for review, since the Federal Circuit's decision is mandated by *Warner-Jenkinson*.

Finally, contrary to Petitioner's argument, nothing in the Federal Circuit's decision makes it difficult to know the scope of claims. The Federal Circuit applied the law consistent with federal precedent. Petitioner simply disagrees with the findings and conclusions. Yet Petitioner could have sought relief by raising these issues in its original appeal. Having failed to do so, Petitioner cannot ask this Court to provide that remedy.

REASONS FOR DENYING PETITION

A. Petitioner Waived Its Complaint Concerning The Construction Of "Sensing Module" In Claim 1 By Failing To Claim Error In Its Appeal.

Petitioner asserts the Federal Circuit improperly imported an element – namely, a "housing" – into Claim 1 in contravention of this Court's decision in *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895), and the Federal Circuit's decision in *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998). In *McCarty*, the lower court's dismissal of an infringement case based on its conclusion the patent was anticipated by prior devices was under review. This Court declined to "read in" features from the specification and drawings to avoid the defense of anticipation and sustain the patent. In *Renishaw*, the Federal Circuit reiterated two canons of claim construction: (a) one may not read a limitation into a claim from the written description; but (b) one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part. *Id.* at 1248. The latter is precisely what the Federal Circuit did, which is consistent with *McCarty* and *Renishaw*. Therefore, the Federal Circuit did not introduce a new criteria for construing a claim.

Petitioner quarrels with the Federal Circuit's construction that the receiving circuit and sensing means (i.e., antenna) are in a "sensing module housing" located adjacent to the door. While Claim 1 does not recite a "sensing module housing," it does recite a "sensing module" that includes a "sensing means" (or antenna) and a

receiving circuit, all of which are located adjacent to the mounted door. While the district court did not use the term "housing" to describe the sensing module that contains the sensing means (or antenna) and the receiving circuit, it reached the same conclusion; namely, these two components are in one unit located adjacent to the monitored door. Based on this construction, the district court found the accused devices did not have both components in a unit adjacent to the monitored door and therefore did not infringe. Petitioner never challenged this construction on appeal and has now waived any right to do so. *See Grupo Mexicano v. Alliance Bond Fund*, 527 U.S. 308, 144 L.Ed.2d 319, 330 n.3, 119 S.Ct. 1961 (1999); *Campbell v. Louisiana*, 523 U.S. 392, 140 L.Ed.2d 551, 562, 118 S.Ct. 1419 (1998); *Pennsylvania Dept. of Corrections v. Yeskey*, 524 U.S. 206, 141 L.Ed.2d 215, 221, 118 S.Ct. 1952 (1998); *Auer v. Robbins*, 519 U.S. 452, 137 L.Ed.2d 79, 92, 117 S.Ct. 905 (1997); *United States v. Alvarez-Sanchez*, 511 U.S. 350, 114 S.Ct. 1599, 128 L.Ed.2d 319 (1994); *Montana Dept. of Rev. v. Kurth Ranch*, 511 U.S. 767, 128 L.Ed.2d 767, 774 n.9, 114 S.Ct. 1937 (1994).

B. The Federal Circuit's Construction Of "Sensing Module" Is Supported By The Claim Language And Specifications

Quite apart from Petitioner's waiver of this claimed error, the Federal Circuit's construction is consistent with the claim language and specifications and drawing as well as the claim construction canons under *Renishaw*. While the Federal Circuit used the term "housing" to describe the composite unit located adjacent to the door, use of the word does not constitute the addition of a

claim element in violation of *McCarty* or *Renishaw*. Whether these components are in a housing or not is not relevant. They are in the "sensing module" which is located adjacent to the door.

According to *Webster's New Universal Unabridged Dictionary*, Deluxe Second Edition, (1983), the word "module" is defined as follows: "In electronics, a compact assembly functioning as a component of a larger unit." Because the module is a compact unit, these components must be located adjacent to the monitored door, whether they are in a housing or not. The common meaning of the word "module" excludes a device where one part of the receiving circuit is located adjacent to the door and the other part is located at some other arbitrary location. That is the conclusion the Federal Circuit reached and it is amply supported by the claim language and the specification.

In fact, the Petitioner admits as much at p. 26 of the Petition for Certiorari where Petitioner argues "modules" are "components gathered together to perform a function." This definition advanced by Petitioner is consistent with a module being a compact unit and is totally *inconsistent* with Petitioner's newly advanced argument that the components can be spread over a large geographic area.

Further, contrary to Petitioner's argument, the specification does not clearly distinguish the physical sensing module from a sensing module housing. At Column 8, lines 8-13 of the '155 Patent, the passage relied on by the Federal Circuit to assist in the construction of "sensing

module," the patentee states: "[t]he switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located and it also has a connection to a source of power." (Joint Appendix before the Federal Circuit, A000084, Col. 8:8-13.) If the housing referred to in these lines of the patent were distinct from the physical sensing module, the system would not function. Use of the word "housing" in Col. 8, ll. 8-13 makes "housing" synonymous with "module," and it is in that sense that the Federal Circuit used "housing." Further, this section of the patent is describing Figure 5, the depiction of the system for a single monitored door, the very subject of Claim 1.

Contrary to Petitioner's argument, the sensing module housing *does* play a role in the reception of the radio signal *and* its application, because it is the sensing module housing to which the switch 168 is connected by leads 170-172, which has the receiver circuit 14 within it, which has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located, and which also has a connection to a source of power. This description by the patentee makes the sensing module housing a functioning part of the system. The kind of housing to which Petitioner refers would not be connected by leads to a switch, would not have an output cable that connects it to a nursing station and would not be connected to a source of power.

There is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification. *Comark*

Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186-7 (Fed. Cir. 1998), citing 1 Donald S. Chisum, *Chisum on Patents*, § 3.02[1] and n.12 (rel. Dec. 1996) ("The line between interpreting claim language in light of the specification and reading a limitation from the specification into the claim is a fine one.") Clearly, the Federal Circuit's analysis is completely consistent with *Renishaw* and *McCarty*.

Petitioner's first question does not raise any conflict with the decisions of this Court or those of the Federal Circuit which warrants review.

C. The Federal Circuit's Conclusions Regarding The Doctrine Of Equivalents Is Consistent With And Mandated By This Court's Decision In *Warner-Jenkinson*

Petitioner argues the amendment to Claim 1 specifying that the receiving circuit is in the sensing module was not an amendment relating to patentability and therefore it was improper for the Federal Circuit to apply prosecution history estoppel to this claim element and preclude infringement under the doctrine of equivalents. Petitioner argues the additional language only reiterates what already was contained in the fourth paragraph of the original Claim 1 by virtue of the language "sensing module including receiving circuit and associated sensing means." Petitioner characterizes the modification to paragraph 5 of Claim 1 as an "editorial" change. Petitioner argues the Federal Circuit's conclusion raises the concern that corrections of mere grammatical mistakes or of a

trivial nature could give rise to prosecution history estoppel. That simply is not the case.

Petitioner never offered to the Federal Circuit this explanation or any other explanation for this amendment. Therefore, under *Warner-Jenkinson*, the amendment is presumed to have been made for patentability reasons. As this Court said in *Warner-Jenkinson*:

> . . . [w]e think the better rule is to place the burden on the patent holder to establish the reason for the amendment required during patent prosecution. . . . Where no explanation is established, however, the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by a amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents to that element. 520 U.S. at 33.

Clearly, the Federal Circuit's decision is consistent with this Court's decision and, therefore, presents no conflict in federal law for this Court to resolve.

Further, Petitioner's belated explanation is not supported by the record before the PTO or the common and ordinary meaning of the language at issue. Petitioner essentially argues the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module." Based on the ordinary and common meaning of the language, that is not true. "[S]ensing module including a receiving circuit" refers to "a" or "one" receiving circuit without indicating there is no other receiving circuit in the system. The original Claim 1 had an ambiguity as to whether the receiving circuit

mentioned in the last element was the same receiving circuit or a different one. Consequently, the receiving circuit mentioned in the last paragraph of the originally drafted Claim 1 was indefinite. A common way of resolving such a difficulty is to identify the receiving circuit mentioned in the last element as "said receiving circuit." The patentee did not do that in the original version of Claim 1, giving rise to the ambiguity. The insertion of the phrase "the sensing module" in the last paragraph of Claim 1 was intended to overcome indefiniteness by narrowing the identification of the receiving circuit mentioned in the last paragraph of the claim from an arbitrary receiving circuit to the specific receiving circuit mentioned in the fourth paragraph of the claim. Therefore, it was not a mere editorial change, but a change relating to patentability.

Petitioner admits as much at p. 21 of the Petition where Petitioner states the amendment was made for "clarity." Further, counsel for the patentee in his response to the rejection characterized the amendment to Claim 1 as clarifying ambiguities. (Joint Appendix before the Federal Circuit A001519.)

D. The Federal Circuit's Conclusions Regarding The "Sensing Means" Based On Claim Differentiation And The "All Limitations" Rule Does Not Warrant Review

Petitioner also quarrels with the conclusion that the "sensing means" or antenna is located in the sensing module. However, Petitioner never claimed error in this construction in its original appeal. Instead, the Petitioner

argued the "sensing means" or antenna and the receiving circuit in the accused devices *could* all be located adjacent to the door and therefore the devices did infringe Claim 1. Having failed to challenge the district court's construction of "sensing means" in their original appeal to the Federal Circuit, Petitioner waived any right to raise this argument now. *See* citations at p. 11, *supra*. Further, Petitioner cannot now advance a construction of Claim 1 contrary to the position taken on appeal. *See Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) (court refused to consider patentee's new theory of claim construction noting that with rare exception appellate courts do not consider a party's new theories lodged first on appeal).

Petitioner makes three additional arguments of error, none of which warrant review by this Court.

First, Petitioner argues that the word "associated" in the claim language "the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored" permits the "sensing means" to be outside of the sensing module which contains the receiving circuit. Petitioner argues, without citation to authority, that "associated with" means "connected with," not "part of." Based on this "definition," Petitioner suggests that in Claim 1 the sensing module includes the receiving circuit but not the associated sensing means and that the receiving circuit is located adjacent to the door opening but the associated sensing means is not. That construction conflicts with the clear meaning of the language "and associated sensing means located adjacent to the door opening to be monitored." (Joint Appendix before the Federal Circuit,

A000085, Col. 9:5-7.) The claim language clearly states the sensing means is located adjacent to the door. The specification explains that for the system to work the "sensing means" or antenna must be adjacent to the door. (Joint Appendix before the Federal Circuit, A000082-83, Col. 3:49-55, Col. 4:1-4, 35-39, Col. 5:61-65.) Further, the use of the word "associated" after "receiver" and before "sensing means" clearly means both components are adjacent to the door. The common and ordinary meaning of "associated" is "to join (things) together or connect (one thing) with another" and "to combine or join with another or others, as component parts." *Webster's Third New International Dictionary Unabridged* at 132 (1981). Based on the common and ordinary meaning of the claim language as corroborated by the specification, the construction by the district court and Federal Circuit is correct.

Second, Petitioner argues that contrary to the Federal Circuit's construction, Claim 4 supports a construction that the "sensing means" may be outside of the sensing module. Again, Petitioner failed to make this argument in its original appeal to the Federal Circuit. Therefore, Petitioner waived this claim of error. Nonetheless, Claim 4 clearly refers to an embodiment of the invention different from the embodiment referred to in Claim 1. In the embodiment referred to in Claim 4, there are two door members and an elongated sensing member extending transversely across at least one of the door members. Under the doctrine of claim differentiation, the embodiment referred to in Claim 1 cannot have two door members and an elongated sensing member transversely across at least one of its door members. The specific language in Claim 1 refers to "a door" or "the door."

(Joint Appendix before the Federal Circuit, A000084-85, Col. 8:58, 62, 63, Col. 9:6-7, 8.) Furthermore, the sensing module in Claim 4 cannot be "located adjacent to the door opening" as required in Claim 1 and yet include "an elongated sensing member extending transversely across at least one of the door members *in* the door opening" as claimed in Claim 4.

Under the doctrine of claim differentiation:

> There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.

Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998) (quoting *Tandon Corp. v. United States International Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987)). Further, the doctrine normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend. *Karlin Technology Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-2 (Fed. Cir. 1999). In short, the doctrine of claim differentiation supports the Federal Circuit's constructions.

Finally, Petitioner quarrels with the Federal Circuit's conclusion that under the doctrine of equivalents, Claim 1 does not encompass devices that have the antenna outside of the sensing module. Petitioner mischaracterizes the analysis as implicating *Festo* to enhance the

chances of its Petition being granted. However, the Federal Circuit did not base its conclusion of non-infringement on *Festo*. Rather the Federal Circuit relied on the doctrine of equivalent's corollary to the "all limitations" rule. Specifically, relying on *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996), the Federal Circuit concluded that once the claim specifies the antenna is in the sensing module, the claim cannot encompass an antenna outside of the sensing module. (Appendix A, p. 16.) As the Federal Circuit in *Athletic Alternatives* explained "the concept of equivalency cannot embrace a structure that is specifically excluded from the scope of claims." *Athletic Alternatives*, 73 F.3d at 1582, citing *Dolly, Inc. v. Spalding J. Evenflo Companies, Inc.*, 16 F.3d 394, 400 (Fed. Cir. 1994). This conclusion is wholly consistent with the well-established tenet that the doctrine of equivalents cannot expand or enlarge the scope of the claims. *Dolly*, 16 F.3d at 398.

Since the court did not reach its decision based on *Festo*, this issue will not be affected by this Court's decision in *Festo* and this question does not warrant review.

CONCLUSION

In sum, the Petitioner does not raise any novel or momentous issues warranting review by this Court. Rather, the Federal Circuit's decision is consistent with and mandated by well-established precedent quite independent of the Court's pending review of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381 (Fed.

Cir. 1999). For these reasons, the Petition for Certiorari should be denied.

Respectfully submitted,

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